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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,467	01/06/2000	Paul W Sternberg	CIT1520-1	3063

7590

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EXAMINER

PARAS JR, PETER

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 10/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/479,467

Applicant(s)

STERNBERG ET AL.

Examiner

Peter Paras, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,26 and 93-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,26 and 93-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continued Prosecution Application

The request filed on May 30, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/479,467 is acceptable and a CPA has been established. An action on the CPA follows.

Applicant's preliminary amendment has been entered. Claims 1, 5, 9-11, 15-17, 21, 25, 27-32, 42, 49, 74-77, 82-82, 88, and 89 have been cancelled. Claims 22 and 26 have been amended. New claims 93-95, as renumbered by Rule 1.126, have been added. Claims 22, 26, and 93-95 are pending and are under current consideration.

The Examiner had previously communicated in the Final Office action of 7/31/02 and the Advisory Action of 2/1/02 that claims 22 and 26 were objected to would be allowable if rewritten in independent form. However, the amendments to claims 22 and 26 have raised new grounds of rejection as set forth below in addition to the rejections of new claims 93-95.

Drawings

New corrected drawings are required in this application because of the objections by the draftsman as indicated in the PTO 948 attached to Paper No: 7, mailed on 8/16/00. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid

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abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 26, and 93-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22 and 26 are indefinite because they depend from cancelled claims, 90 and 91 respectively. Claims 90 and 91 have been cancelled in Applicant's amendment received on 5/11/01. It would appear that Applicants intend for claims 22 and 26 to depend from renumbered claims 93 and 94 respectively.

Claims 93-95 are indefinite as follows: step (c) of the claims recites a sequence of nucleotides that encodes a *Caenorhabditis* LOV-1 gene. However, it is unclear how a sequence of nucleotides can encode a LOV-1 gene. Neither the prior art nor the instant specification has defined how a sequence of nucleotides can encode a LOV-1 gene. The specification and prior art have recognized that a nucleotide sequence encodes a protein. Appropriate correction is required.

Claims 93-95 are indefinite as follows: step (c) recites sequence of nucleotides that encodes a *Caenorhabditis* LOV-1 gene and that hybridizes along its full length to the full length of at least one of the exons set forth in SEQ ID NO: 3. However, it is

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unclear how a sequence encoding a LOV-1 gene, which is understood to refer to the full length gene, can hybridize along its full length to at least one of the exons set forth in SEQ ID NO: 3. Furthermore, it is unclear how a full length gene, presumably including introns as would be expected to be part of the full length gene, can hybridize along its full length to at least one of the exons of SEQ ID NO: 3. Since a LOV-1 gene is longer than at least one exon of SEQ ID NO: 3 (as is consistent with the discussion of the LOV-1 gene provided by the specification), it is unclear how a LOV-1 gene can hybridize along its full length to at least one exon of SEQ ID NO: 3. Appropriate correction is required.

Allowable Subject Matter

Appropriate correction of the rejections under 35 U.S.C. 112, 2nd paragraph rejection may be sufficient to place the instant application in condition for allowance.

Conclusion

No claim is allowed. Claims 22, 26, and 93-95 appear to be free of the prior art of record.

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Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Patsy Zimmerman whose telephone number is (703) 308-0009.

Peter Paras, Jr.

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Pete Paras Jr
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